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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,542	03/02/2004	Vinay G. Sakhrani	TFR-001	3383

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EXAMINER	
ZACHARIA, RAMSEY E	
ART UNIT	**PAPER NUMBER**
1773	

DATE MAILED: 07/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/791,542	SAKHRANI ET AL.	
	Examiner	Art Unit	
	Ramsey Zacharia	1773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *30 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-30* is/are pending in the application.

4a) Of the above claim(s) *1-9 and 19-24* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-18 and 25-30* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *02 March 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Listing of Claims

2. The applicant is reminded that 37 CFR 1.121(c) requires the listing of claims in any amendment to include the text of all pending claims, including withdrawn claims.

Claim Rejections - 35 USC § 102

3. Claims 10-12, 14-18, 25-28, and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Williams et al. (U.S. Patent 4,822,632).

Williams et al. teach a surface coated with a lubricant wherein at least one of the surface and the lubricant is treated with an ionizing plasma (column 2, lines 34-41). That is, the surface and/or deposited lubricant are treated with ionizing plasma. The preferred lubricant is a polydialkylsiloxane (column 3, lines 47-48), i.e. a polysiloxane-based compound. The plasma may be generated from a variety of gasses, such as air, hydrogen, helium, etc. and performed at any pressure (column 4, lines 12-24). The lubricant may be applied neat or in a solvent with the subsequent removal of the solvent by evaporation (column 3, lines 63-65). In the embodiment of Example II, the lubricant is applied from a 1.5 wt% solution (column 5, lines 29-33). In the embodiment of Example II, the lubricant comprises a blend of a low viscosity silicone and a higher viscosity silicone (column 5, lines 65-68).

Regarding the limitation that the lubricant is exposed to an energy source at atmospheric pressure, one skilled in the art would readily envisage atmospheric pressure because Williams et al. teach that any pressure can be used.

Williams et al. teach the use of a blend of silicones having different viscosity. Regarding claims 14 and 30, one of silicones reads on the lubricant while the other reads on a viscosity modifier and/or an antiwear agent (since lubricants are designed to reduce wear).

Claim Rejections - 35 USC § 102 / 103

4. Claims 10-12, 14-18, 25-28, and 30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Williams et al. (U.S. Patent 4,822,632).

Williams et al. teach all the limitations of claims 10-18 and 25-31, as outlined above, except for illustrating embodiments in which certain recited product-by-process limitations are disclosed, for examples, exposure at atmospheric pressure and the drying conditions of the lubricant-solvent solution. When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claim in a product-by-process claim, the burden is on the applicant to present evidence from which the examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. *In re Brown*, 459 F. 2d 531, 173 USPQ 685 (CCPA 1972); *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). This burden is NOT discharged solely because the product was derived from a process not known to the prior art. *In re Fessman*, 489 F. 2d 742, 180 USPQ 324 (CCPA 1974). Furthermore, the determination of patentability for a product-by-process claim is based

on the product itself and not on the method of production. If the product in the product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985) and MPEP § 2113. In this case, the article of Williams et al. appears to be the same as that of the claimed invention and the burden is on the applicants to conclusively demonstrate that the claimed invention differs from that of Williams et al.

Claim Rejections - 35 USC § 103

5. Claims 13 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Patent 4,822,632) in view of Lubrecht (U.S. Patent 6,200,627).

Williams et al. teach all the limitations of claims 13 and 29, as outlined above, except for the use of a fluorochemical, perfluoropolyether, or functionalized perfluoropolyether compound as the lubricant. However, Williams et al. do teach that any suitable silicones oil may be used as the lubricant (column 3, lines 43-45).

Lubrecht is directed to a syringe coated with a silicone lubricant (column 1, lines 9-12). The silicone may be a polydimethyl siloxane, i.e. a polyalkyl siloxane, (column 3, lines 21-22) or it may be a fluorine-substituted silicone (column 3, lines 55-58). A fluorine-substituted silicone is a fluorochemical since it is a chemical that contains fluorine.

Lubrecht demonstrates that a fluorine-substituted silicone may be as a silicone lubricant in applications such as syringes where other silicone, such as polyalkyl siloxanes, may also be used. That is, Lubrecht shows that fluorine-substituted silicones are suitable for use in the application to which the Williams et al. reference is drawn. As the courts have held that the

selection of a known material based on its suitability for its intended use is *prima facie* obvious (see MPEP 2144.07), it would have been obvious to one skilled in the art to use a fluorine containing silicone as the silicone oil of Williams et al., particularly since Williams et al. explicitly teach that any suitable silicone may be used.

Response to Arguments

6. Applicant's arguments filed 30 March 2006 have been fully considered but they are not persuasive.

The applicants argue that the invention as claimed is not anticipated by Williams et al. because Williams et al. covers only a specific class of lubricants (silicone oils and hydrocarbon oils) while the scope of the applicants' invention encompasses fluorochemcial compounds as well as polysiloxane-based compounds.

This is not persuasive for at least the reasons that claims 10-12, 14-18, 25-28, and 30 do not limit the lubricant to fluorochemcial compounds. Moreover, it is noted that Williams et al. is not limited to silicone and hydrocarbon oils but rather Williams et al. explicitly teach the use of synthetic oils as the preferred lubricant (column 3, lines 40-43). Furthermore, the teachings of Williams et al. are not restricted to only the oils explicitly cited, the cited oils are referred to as "[s]uitable lubricants" not exclusive lubricants.

The applicants further argue that the invention as claimed is not anticipated by Williams et al. because Williams et al. does not teach treatment at pressures other than the extreme vacuum necessary to generate a plasma with the Fletcher invention.

This is not persuasive because Williams et al. explicitly teach that "any gas pressure may be used." The Fletcher reference is cited as an example of a plasma generator; but again Williams et al. teach that "[t]he plasma treatment may be carried out in any plasma generator." The courts have held that a reference may be relied upon for all that it would have reasonably suggested to one having ordinary skill the art, including nonpreferred embodiments. See MPEP 2123.

The applicants argue that the claims are not obvious over Williams et al. because Williams et al. fails to disclose or provide any suggestion that their invention can be modified for the use of fluorochemical lubricants or the exposure of the lubricant to an energy source at atmospheric pressure. However, as noted above, (1) Williams et al. do explicitly state that any gas pressure may be used, (2) Williams et al. is not limited to silicone or hydrocarbon oils but rather teach that synthetic oils are the preferred lubricants, and (3) the invention of claims 10-12, 14-18, 25-28, and 30 are not limited to fluorochemical lubricants.

Regarding the product-by-process limitations, the applicant has not demonstrated that exposing the lubricant to the energy exposure at about atmospheric pressure results in a different *product* than exposing the lubricant to an energy source at any other pressure. No comparative data is presented contrasting exposures at different pressures; the only difference appears to be one of economic infeasibility (paragraph 0006 states that treating the lubricant with plasma generated under a vacuum is said to render the process "impractical for large-scale production operations") and the fact that a combination would not be made by businessmen for economic reasons does not mean that a person of ordinary skill in the art would not make the combination

because of some technological incompatibility. *In re Farrenkopf*, 713 F.2d 714, 219 USPQ 1 (Fed. Cir. 1983).

Conclusion

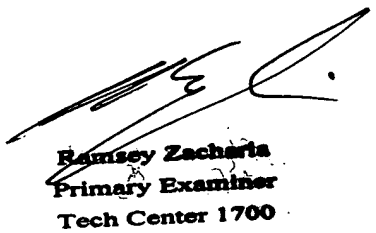
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey Zacharia whose telephone number is (571) 272-1518. The examiner can normally be reached on Monday through Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney, can be reached at (571) 272-1284. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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Primary Examiner
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